

Appl. No. 09/394,660

Responsive to the Office Action Dated January 17, 2003

REMARKS

This is responsive to the Office Action dated January 17, 2003 in which claims 4-6, 10, 13, 14, 33, 34 and 37 were examined. As a result of this Amendment, claims 4-6, 10, 13, 14, 33, 34, 37 and 40-47 are now pending in this application, all other claims having been cancelled.

The Detailed Action portion beginning on pg. 2 of the Office Action of January 17, 2003 indicates that claims 4, 13 and 14 are allowable and that claims 5, 6, 10, 33, 34 and 37 were rejected under 35 U.S.C. § 103. This is different from the Office Action Summary indicating that claims 4, 13 and 14 were rejected and that the other claims were objected to. Applicants' counsel contacted the Examiner on May 22, 2003 for clarification of this discrepancy and was advised that the Office Action Summary includes typographical errors transposing the listing of claims in Ins. 6 and 7 of the Disposition of Claims section of the Office Action Summary. Therefore, this Amendment is based on the treatment of the claims presented in the Detailed Action and not the Office Action Summary portion.

With respect to the allowable claims, Applicants greatly appreciate the indication that claims 4, 13 and 14 are allowable over the prior art. Nevertheless, paragraph 7 on pg. 4 of the Detailed Action refers to rejections under 35 U.S.C. § 112 set forth in that Office Action. However, the Office Action of January 17, 2003 does not include any § 112 rejections. The Examiner indicated on May 22nd that the reference to

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§ 112 rejections in paragraph 7 of the Detailed Office Action is a typographical error.

Applicants are proceeding with this Amendment accordingly.

In that claims 4, 13 and 14 are indicated to be allowable over the prior art, Applicants have amended each of those claims to be in independent form and to include all of the limitations of the base claim and any intervening claims. Additionally, claims 40-43 have been added herein, each of which are dependent claims based upon either claim 4 or 13. Each of claims 40-43 correspond to one of claims 5, 6, 34 or 37. As a result, Applicants respectfully assert that claims 4, 13, 14 and 40-43 are allowable over the prior art, include subject matter previously elected for prosecution in this case and are in condition for allowance.

Claims 5, 6, 10, 33, 34 and 37 were previously indicated to be allowed over the prior art, but are now rejected under § 103(a) in view of the newly cited 1963 reference, U.S. Patent No. 3,102,671 (Gershen), directed to a tape dispenser. Applicants respectfully traverse the § 103 rejection of claims 5, 6, 10, 33, 34 and 37 and, as a result, have not amended those claims herein.

The rejection alleges that Gershen discloses a dispenser with almost every structural limitation of the claimed invention, but acknowledges that Gershen fails to disclose a powered drive module and a checkout counter as claimed.

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Challenge to Official Notice

The Office Action indicates that the Examiner takes Official Notice that such drive modules are old and well known in the art, particularly in the art of tape dispensers, and that it is also old and well known to provide a dispenser on checkout counters. Applicants respectfully traverse the rejections of these claims and challenge the Official Notices in the rejections. Therefore, Applicants respectfully demand evidence proving the alleged prior art of each of the Official Notices cited in the Office Action.

In this regard, Applicants would like to note the admonition provided by the CCPA on this point:

[T]his court will always construe [the rule permitting judicial notice] narrowly and regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. *Cf. In re Cofer*, 53 CCPA 830, 354 F.2d 664, 148 USPQ 268 (1966), *In re Borst*, 52 CCPA 1398, 345 F.2d 851, 145 USPQ 554 (1965). Allegations concerning specific "knowledge" of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge. *See In re Spormann*, 53 CCPA 1375, 363 F.2d 444, 150 USPQ 449 (1966). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982) citing *In re Ahlert*, 57 CCPA 1023, 1027, 424 F.2d 1088, 1091, 165 USPQ 418, 420-21 (1970).

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Non-Analogous Art

Gershen is non-analogous art and therefore, may not be relied on as a basis for rejecting the pending claims.

As stated in the MPEP, "[i]n order to rely on a reference as a basis for rejection of an Applicants' invention, the reference must either be in the field of Applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned". See MPEP 2141.01(a), page 2100-115 second column - page 2100-116 first column, 8th edition (August 2001), including the summaries of *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992) and *In re Clay*, 23 USPQ2d 1058 (Fed. Cir. 1992).

As seen from a comparison of the Applicants' invention with Gershen, the field of endeavor and problem to be solved are so far removed from one another, that the "analogous art" hurdle established by MPEP 2141.01(a) has not been met.

In further detail, the Applicants' invention is directed to a ticket dispensing installation specifically for the merchandising, sale and distribution of lottery tickets joined together in a strip by lines of weakness or perforations and stored in a stack at a retail establishment. The problem addressed by Applicants' invention is to maximize the exposure of those tickets to consumers while minimizing the disruption of the retail sales environment and associated aspects of lottery ticket sales transactions. As a solution, Applicants have invented a convenient, highly functional, stationary, robust

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and user-friendly ticket merchandising device in the form of a ticket dispenser that provides high visibility for the tickets in a retail checkout counter environment.

In stark contrast, Gershen is directed to a tape dispenser and, more specifically, a tape dispenser for holding and dispensing hard-to-tear tape from a roll which may be replaced when the tape is used up (Col. 1, Ins. 8-11). The problem being solved by the tape dispenser in Gershen is the ability to readily and safely dispense hard-to-tear tape from a roll in which the dispenser may be refilled once the roll of tape is used up. Tape dispensers of the type disclosed in Gershen are typically hand-held, transportable units for convenient use at a variety of locations wherever taping applications may be required. The Gershen invention solves the problem of the convenient physical transportation and dispensation of hard-to-tear tape.

On the other hand, Applicants' invention is a stationary ticket merchandising system which in one aspect includes a ticket dispenser for dispensing tickets from a stack while providing appealing visual access to the tickets through a transparent portion of the cover. A convenient check writing surface for the consumer and a user-friendly, secure dispenser that does not require manual dispensing or manipulation of the tickets before the transaction between the consumer and store clerk are also parts of this invention. Therefore, Applicants respectfully assert that Gershen is nonanalogous art because it deals neither with the field of Applicants' endeavor nor is it pertinent to the particular problem with which the present inventors were concerned and the rejection fails to establish these factors. In fact, the rejection acknowledges

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that Gershen relates to the art of tape dispensers, but Applicants point out it is not automated tape dispensers nor lottery ticket dispensers utilizing a merchandising scheme.

As may be seen from the information presented above, the field of endeavor and problem being solved for the Applicants' invention is sufficiently different from that of Gershen, that Gershen may not properly be considered analogous art under the analysis of MPEP 2141.01(a).

Moreover, a person of ordinary skill in the tape dispenser art would not reasonably have expected to solve issues of ticket merchandising and sales in the lottery field, by considering a reference dealing with adhesive tape handling and dispensing of hard-to-tear tape from a roll which may be replaced when the tape is used up (Col. 1, Ins. 8-11). See MPEP 2141.01(a), page 2100-116, column 1, 8th edition (August 2001).

Impermissible Hindsight

The examiner has used improper hindsight reasoning, and therefore, a *prima facie* case of obviousness has not been established.

As acknowledged by the MPEP, "[a]ny judgment on obviousness is in a sense necessarily reconstruction based on hindsight reasoning". However, the MPEP explicitly states that such a reconstruction is proper only when two conditions are met. The first condition is that an examiner's reasoning take into account only knowledge

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which was within the level of ordinary skill in the art at the time the claimed invention was made. The second condition is that the examiner's reasoning does not include knowledge gleaned only from an Applicants' disclosure. See MPEP 2145 X. A., page 2100-152, 8th Edition (August 2001).

Furthermore, in establishing a *prima facie* case of obviousness, it is the examiner who has the initial burden of establishing the level of ordinary skill in the art. See MPEP 2141, pages 2100-112 - 2100-114, 8th Edition (August 2001). As further noted in the MPEP, the examiner's ascertainment of the level of ordinary skill is a necessity in order to maintain objectivity in the obviousness inquiry. See MPEP 2141.03, page 2100-121, column 1, second paragraph, 8th Edition (August 2001). Admittedly, the MPEP provides one scenario in which an examiner is not required to establish the level of ordinary skill in the pertinent art. If the only facts of record pertaining to the level of skill in the art are found within the prior art of record, and the prior art itself reflects an appropriate level, then an examiner is relieved of this obligation. See MPEP 2141.03, page 2100-121, column 1, paragraph 1, 8th Edition (August 2001). However, in the current situation, the prior art does not reflect an appropriate level, and therefore, the examiner is not relieved of his burden to determine, on the record, the level of ordinary skill in the relevant art. For example, nothing in Gershen reflects that a person of ordinary skill in the ticket merchandising art would turn to the adhesive tape dispensing art. Accordingly, because the examiner has

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not established the level of ordinary skill in the reference art, as required, a *prima facie* case of obviousness has not been established.

The Examiner's hindsight reasoning in combining Gershen and other alleged prior art also is impermissible because this reconstruction includes knowledge gleaned only from the Applicants' disclosure, something which is prohibited by the MPEP, as noted above. In further detail, in reading the Applicants' disclosure, the examiner read about the problems which the Applicants had identified, as well as the Applicants' inventive solutions to those problems. It appears that the examiner then took this knowledge — knowledge gleaned only from the Applicants' disclosure — and developed a rationale for combining Gershen and other alleged prior art. However, as noted above, this type of hindsight reasoning is an impermissible rationale for combining references, and therefore, a *prima facie* case of obviousness has not been established.

Claim Elements Missing from Prior Art

Additionally, Applicants traverse the § 103 rejections of claims 5, 6, 10, 33, 34 and 37 because the rejection does not address each and every feature of the invention recited in one or more of those claims. Specifically, claim 6 which depends directly from claim 33 recites that the front cover includes a portion that is at least partially transparent and that the front cover includes a curved portion. These features can be clearly seen in Figs. 1 and 2 in Applicants' specification. However, after a

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careful study of the Gershen reference and the alleged prior art described in the Office Action for which the Examiner has taken improper Official Notice, Applicants are unable to identify any teaching, disclosure or suggestion of a transparent front cover portion. The transparent portion of the front cover is advantageous to Applicants' invention to provide a clear view of the tickets being offered for sale and dispensed in the merchandising installation of the lottery tickets. Such a feature is not present in Gershen and not necessary because of the difference in the problems being solved by the respective inventions, as well as the utilization of those devices.

Similarly, while it has been detailed that the Gershen device is for hard-to-tear tape, Applicants' invention is specifically directed for use with one or more strips or arrays of lottery tickets, each delineated from one another by lines or perforation or weakness. These features are specifically recited in claims 10 and 33; however, they are entirely absent from Gershen and the other alleged prior art presented in the § 103 rejection.

Moreover, claim 5, which depends directly from claim 33, recites specific features and aspects of the drive module, none of which are addressed in the rejection or the alleged Official Notice recitation in the Office Action.

For each and all of these reasons, Applicants respectfully traverses the rejection of claims 5, 6, 10, 33, 34 and 37 and request reconsideration of same in light of the comments and remarks provided herein.

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New Claims

With respect to the claims newly added herein, claims 40-43 merely recite features or aspects already included in previously pending and examined claims. Claims 44-47 recite specific features or aspects of the rear cover recited in the claims. Specifically, a dispensing slot identified by reference numeral 56 and clearly shown in Fig. 3 of Applicants' specification and various aspects of that slot are recited in new claims 44-47. Applicants respectfully assert that despite the other deficiencies previously enumerated herein with respect to Gershen, that the tape dispenser disclosed in Gershen fails to teach, disclose or otherwise suggest a dispensing slot as recited in claim 44-47 and the associated orientation of that slot. As such, Applicants respectfully assert that claims 44-47 are both novel and nonobvious over the cited art of record for these additional reasons.

Summary

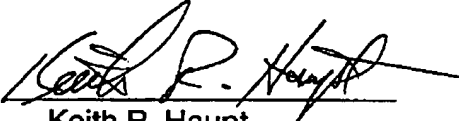
As a result of the amendments to the claims and remarks given herein, Applicants respectfully assert that each of the rejections and objections identified in the Office Action have been overcome. As such, Applicants request Notice of Allowance with respect to the now pending claims at the Examiner's earliest convenience. If the

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Examiner feels that any matter in this case requires further attention prior to issuing a Notice of Allowance, he is asked to telephone the undersigned attorney so that the matter may be promptly resolved.

Respectfully submitted,

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